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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,234	07/21/2003	Stephen Ritland	4510-10	7545
22442	7590	07/25/2008	EXAMINER	
SHERIDAN ROSS PC			COMSTOCK, DAVID C	
1560 BROADWAY				
SUITE 1200			ART UNIT	PAPER NUMBER
DENVER, CO 80202			3733	
			MAIL DATE	DELIVERY MODE
			07/25/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/624,234	RITLAND, STEPHEN	
	<b>Examiner</b>	<b>Art Unit</b>	
	DAVID COMSTOCK	3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 11 April 2008.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 and 26-35 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) 12-20,26-29,31-33 and 35 is/are allowed.  
 6) Claim(s) 1-9,11,30 and 34 is/are rejected.  
 7) Claim(s) 10 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 21 July 2003 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____ .                        |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11, 30 and 34 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 6, “the image tracker” lacks antecedent basis. It is unclear whether the newly added preamble language “surgical aid assembly” is intended to be directed to the same structure as the “device for stabilizing an image tracker” or if some new structure is implied. In any event, as presently worded, the claim requires correction to clarify its scope. The dependent claims are merely rejected because of their dependency on the independent claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Caesar (US Pat 2825329).

In regards to claims 1-3, Caesar discloses having a device (mounting base) with a securing mechanism (means for securing) (158), a body (150), a first and second aperture (156, one on each side of the body), projection (means for stabilizing) (152) located at the bottom of the body, which is noted to be a pin. It is acknowledged that functional language is as important as the structural limitations. However, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. (See MPEP 2114). If the functional language is silent in the prior art, then the examiner will determine if the prior art can inherently perform the claimed function. To establish inherency, extrinsic evidence must be presented. In this case, the extrinsic evidence is the structural similarity to the disclosed invention (*In re Schreiber*, 128 F.3d.1473, 44 USPQ2d 1429 (Fed Cir 1997)).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caesar (US Pat 2825329).

Caesar discloses apertures in the body. The apertures can be considered to be "along," e.g. adjacent to or near, any part of the body. They are "along" the top. They

are "along" the bottom. They are "along" the sides. Even if the apertures were not considered to be "along" the sides, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided apertures along the sides of the body, for example to accommodate varying patient anatomy or conditions, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Claims 11, 30 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caesar (US Pat 2825329) in view of Maruyama et al. (US Pat 5487741).

Caesar discloses the claimed invention except for having flanges in the apertures. Flanges are commonly used to provide a better fit for extra strength in holding objects. Maruyama disclose a bone plate having apertures with flanges (23a, 25a). It would have been obvious to one skilled in the art at the time the invention was made to construct the invention of Caesar, including flanges in view of Maruyama in order to provide greater strength of holding between the screw and body.

#### ***Allowable Subject Matter***

Claims 12-20, 26-29, 31-33 and 35 are allowable over the prior art of record.

Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable over the prior art of record if rewritten in independent form including all of the limitations of the base claim, as corrected, and any intervening claims.

***Response to Arguments***

Applicant's arguments filed 11 April 2008 have been fully considered but are not fully persuasive.

In response to Applicant's amendment, wherein the image tracker is positively recited in claims 12, 26 and 28, in combination with other claim limitations, the prior art rejection over these claims has not been maintained. Regarding claim 10, the closed preamble transition "consisting of" is sufficient to overcome the outstanding rejection since the securing mechanism must pass through two apertures and consist of only a single screw. It is still noted that an "attachment point" may simply be a location at which an image tracker is capable of being attached, e.g. by hooking or screwing one of the navigation stars on an edge of the device; it is noted that the image tracker is not recited in the rejected claims and the body must merely be capable of performing the intended use implied by the "attachment point." A screw is inherently capable of acting as a mounting post. In response to Applicant's argument that claim 1 "[has] been amended to recite an image tracker within the body of the claim," it is noted that no such amendment is present in claim 1. In fact, not only has claim 1 not been amended to positively recite an image tracker, it now lacks clarity and requires correction (see rejection under 35 USC 112, above). Regarding the location of holes in a plate, it is hardly necessary to provide an affidavit to show that would be obvious, since it has already been held that mere relocation of parts of an invention involves only routine skill

in the art. *In re Japikse*, 86 USPQ 70. Moreover, it is noted that the claimed holes must merely be “along,” e.g. adjacent to or near, various portions of the device. The rejection does not require putting lateral holes into the thin material of the plate through a side surface thereof.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710. Please leave a detailed voice message if examiner is unavailable. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo

Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David Comstock/

Examiner, Art Unit 3733

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733